

REMARKS

Claims 9 – 17 are presently pending. The Office Action asserts the following:

Claims 9, 10, 15, and 17 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by Tanaka (Japanese Patent No. 9-67909);

Claims 9, 16, and 17 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by Weisner (U. S. Patent No. 4,848,051);

Claims 9 - 14 and 17 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by Weisner; and

Claims 9, 10, 12, and 14 - 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over German Patent No. 19734346 in view of European Patent No. 0148,429 to Handel.

Claim 9 is an independent claim; Claims 10 – 17 are dependent claims.

Applicants respectfully traverse the rejection.

To anticipate, every element and limitation of the claimed invention must be found in Lindgren. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). A determination of invalidity based on anticipation under 35 U.S.C. § 102(b) requires a finding that “each and every limitation is found either expressly or inherently in a single prior art reference.” Celeritas Techs. Ltd. v. Rockwell Int'l Corp., 150 F.3d 1354, 1360, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998). Although the Office Action states that the cited references disclose certain aspects, review of each of those references shows otherwise.

Claim 9 requires a “rigid flashing profile connected to one of the elements of the frame.” The Office Action says that Tanaka’s component 104 is such a feature. However, clearly Tanaka’s component 104 is not rigid at all, but is instead the opposite: component 104 is pliable. For at least that reason, Claim 9, as well as Claims 10, 15, and 17 depending from Claim 9 cannot be anticipated by Tanaka. Moreover, Claim 10 requires a “raised folded portion” which is not disclosed by Tanaka, and Claim 15 requires “a channel for the drainage of water” which is not disclosed by Tanaka, further showing that these claims cannot be anticipated by Tanaka.

Claim 9 requires a “first flashing leg carried by one of the elements of the frame” and “a flexible section attached to the second flashing leg.” Weisner simply discloses no such arrangement. The Office Action says that Weisner’s component 19 is a first flashing leg and component 17 is a second flashing leg, but Weisner itself defines component 44 to be the flashing. For at least that reason, 9, as well as Claims 10 – 14, 16, and 17 depending from Claim 9, cannot be anticipated by Weisner.

To sustain a *prima facie* case of obviousness under 35 U.S.C. §103(a), the teachings of the references must be viewed in their entirety, i.e., as a whole,. Further, the appropriate test under 35 U.S.C. §103(a) is not whether the differences between the prior art and the claims are obvious, but instead whether the claimed invention as a whole would have been obvious. The differences between a particular claim and the cited references cannot be viewed in a vacuum. In this case, when properly viewed as a whole, there is simply no motivation to combine German Patent No. 19734346 with Handel in the manner suggested in an attempt to render obvious the present claims. Thus, for at

least this reason, Applicants respectfully submit that Claims 9, 10, 12, and 14 - 17 patentably define over the cited references, taken alone or in any proper combination.

In view of the foregoing, Applicants disagree with and do not acquiesce in the Office Action's rejections. Notwithstanding, Claim 9 has now been amended as shown, to even further patentably define over the cited references. Moreover, in that Claims 10 - 17 depend from Claim 9, they, too, even further patentably define over the cited references.

Applicants respectfully submit that all issues raised in the Office Action have been fully addressed, and the application, including all pending claims, is in complete condition for allowance.

The Examiner is encouraged to contact the undersigned at her convenience should he have any questions regarding this matter, or to resolve any remaining issues.

Please charge any fees required this Request to Deposit Account No. 50-3959.

Respectfully submitted,

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